

REMARKS

Claims 1 through 7, 9, 10, and 12 through 31 are currently pending in the application.

Claims 1 through 7, 9, 10 and 12 are currently under examination.

Claims 13 through 31 are withdrawn from consideration as being drawn to a non-elected invention.

Claims 1 through 7, 9, 10 and 12 stand rejected. This amendment is in response to the Office Action of May 23, 2006.

35 U.S.C. § 102(e) Anticipation Rejections

Anticipation Rejection Based on Ishiwata et al. (U.S. Patent 6,102,023)

Claims 1, 9, 10 and 12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ishiwata et al. (U.S. Patent 6,102,023).

Applicants assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Brothers v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Turning to the cited prior art, the Ishiwata et al. reference describes a cutting apparatus comprising a chuck table and first and second cutting means each including a spindle unit attached to a movable base having a blade attached thereto.

Applicants assert that the Ishiwata et al. reference does not and cannot anticipate the claimed invention of presently amended independent claim 1 under 35 U.S.C. § 102 because the Ishiwata et al. reference does not identically describe, either expressly or inherently, each and every element of the claimed invention in as complete detail as contained in the claim.

Applicants assert that the Ishiwata et al. reference does not identically describe the elements of the claimed invention of presently amended independent claim 1 calling for "a support having an

extension arm connected thereto” and “a saw attached to the extension arm of the support, the saw having at least two blades connected thereto supported above a table by the support and oriented to cut mutually parallel paths in a surface of a semiconductor substrate positioned on the table, at least one of the saw blades horizontally translatable on said support and the other saw blade having a fixed horizontal position on said support”. In contrast to the claimed invention of presently amended independent claim 1, Applicants assert that the Ishiwata et al. reference describes two saws connected to separate spindle units, not a saw unit having two blades connected to an extension arm connected to a support. Therefore, presently amended independent claim 1 is allowable as well as dependent claims 2 through 7, 9, 10 and 12 therefrom.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Ishiwata et al. (U.S. Patent 6,102,023) in view of Tieber (U.S. Patent 6,187,654)

Claims 2 through 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishiwata et al. (U.S. Patent 6,102,023) in view of Tieber (U.S. Patent 6,187,654). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants assert that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants’ disclosure.

After carefully considering the cited prior art, the rejections, and the Examiner’s comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Turning to the cited prior art, the Ishiwata et al. reference describes a cutting apparatus comprising a chuck table and first and second cutting means each including a spindle unit attached to a movable base having a blade attached thereto.

The Tieber reference describes an arrangement to support a substrate during a dicing process. The arrangement includes a nest having a first nest side and a second nest side. The nest includes a grid which defines at least one nest opening. The nest opening has an opening area that is smaller than an area of a die diced from the substrate. The arrangement further includes a vacuum retainer plate having thereon at least one vacuum pedestal. The vacuum pedestal protrudes above the first nest side of the nest when the vacuum pedestal is disposed through the nest opening from the second nest side to support the substrate on the upper surface and lift the substrate off the first nest side when the substrate is positioned on the nest with the first substrate side facing the first nest side and when the nest is mated with the vacuum retainer plate.

Applicants assert that any combination of the Ishiwata et al. reference and the Tieber reference fails to teach or suggest the claim limitations of presently amended independent claim 1 to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed invention because any combination of the Ishiwata et al. reference and the Tieber reference fails to teach or suggest all the claim limitations of presently amended independent claim 1.

Applicants assert that any combination of the Ishiwata et al. reference and the Tieber reference fails to teach or suggest the claim limitations of presently amended independent claim 1 calling for “a support having an extension arm connected thereto” and “a saw attached to the extension arm of the support, the saw having at least two blades connected thereto supported above a table by the support and oriented to cut mutually parallel paths in a surface of a semiconductor substrate positioned on the table, at least one of the saw blades horizontally translatable on said support and the other saw blade having a fixed horizontal position on said support”. In contrast to the claimed invention of presently amended independent claim 1, Applicants assert that any combination of the Ishiwata et al. reference and the Tieber reference, at best, describes two saws connected to separate spindle units, not a saw unit having two blades connected to an extension arm connected to a support. Therefore, presently amended independent claim 1 is allowable as well as dependent claims 2 through 7, 9, 10 and 12 therefrom.

Applicants submit that claims 1 through 7, 9, 10 and 12 are clearly allowable over the cited prior art.

Applicants request the allowance of claims 1 through 7, 9, 10 and 12 and the case passed for issue.

Respectfully submitted,



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